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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,952

11/24/2003

Craig L. Reding

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EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2614

NOTIFICATION DATE

DELIVERY MODE

06/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,952	<b>Applicant(s)</b> REDING ET AL.	
	<b>Examiner</b> MD S. ELAHEE	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/22/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 12/17/2009. Claims 1-14 and 19-26 are pending. Claims 15-18 have been added.

### ***Response to Arguments***

2. Applicant's arguments filed in 12/17/2009 remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

5. Claim 26 recites a computer-readable medium comprising instructions. Claim language does not comply with the requirements of MPEP 2106.01.I. The “medium” is only recited once in the invention disclosure (Preamble of Claim 26). Since “medium” is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal. Furthermore, “computer program” or “software” is merely a set of instructions. On the contrary, “memory”, “computer program” and “software” are well defined acceptable terminology in computer programming. Additionally, comprising is not an acceptable linking word to associate “computer readable medium” to a “computer program product”. Computer program is data structure. The claimed instructions are merely data structure. Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Claim 26 fails to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed computer-readable medium does not comprise instructions to cause a processor to perform the storing, receiving, converting and transmitting functions of the claim then the Applicant has not complied with 35 U.S.C 101.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-12 of co-pending application no. 10/720,920. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except receiving a notification at a server.

8. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending application no. 10/858,973. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except displaying step.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-14 and 19-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, the limitation “receiving incoming call data” and “converting the incoming call data” were not disclosed in the original specification. The original specification states “receiving incoming notification” and “converting the incoming notification”.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-14 and 19-26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the data format" in line 9 of the call. There is insufficient antecedent basis for this limitation in the claim. It appears that the limitation would be “the format”.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-14, 19-21 and 23-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cloutier (US 6,459,913).

Regarding claims 1, 12, 19, 26, with respect to Figures 1-3 and 9, Cloutier teaches a method comprising:

storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user (fig.9, step 1006; col.3, lines 18-43, col.8, lines 17-23, 52-55);

Cloutier further teaches receiving incoming call data indicating an incoming call directed to one of the plurality of devices associated with the user from a calling device associated with a caller, the incoming call data being in a format for the calling device (fig.9, step 1000; col.8, lines 17-23, 37-42);

Cloutier further teaches converting the incoming call data from the data format for the calling device into a data format for the preferred device (fig.9, step 1014; col.6, lines 62-67, col.9, lines 11-24); and

Cloutier further teaches transmitting the notification to the user's preferred device (fig.9, step 1032; col.9, lines 22-24).

Regarding claim 2, Cloutier, as applied to claim 1, teaches receiving user selection of the preferred device (fig.9, step 1006).

Regarding claims 3, 14 and 21, Cloutier, as applied to claims 1, 13 and 20, teaches that receiving a user selection of a time period during which notifications are to be transmitted to the preferred device (col.6, lines 1-35, 53-62).

Regarding claim 4, Cloutier, as applied to claim 1, teaches that receiving a user selection of a device for which notifications are to be transmitted to the preferred device (fig.9, step 1006; col.6, lines 1-35, col.8, lines 52-55).

Regarding claims 5 and 20, Cloutier, as applied to claims 1 and 19, teaches receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device (col.4, lines 5-22).



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Regarding claim 6, Cloutier, as applied to claim 5, teaches that the user selection of calling parties comprises using a calendar function for specifying date-specific notifications (col.6, lines 1-35, 53-62).

Regarding claim 7, Cloutier, as applied to claim 1, teaches receiving user specifications for receiving notifications by a preferred device based on at least one of the time of day or calling party (col.6, lines 1-35, 53-62).

Regarding claim 8, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a wireless phone capable of displaying text messages (col.3, lines 18-43, col.7, lines 29-33, col.8, lines 17-23, 52-55).

Regarding claim 9, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a landline phone (col.3, lines 18-43, col.7, lines 1-7, 53-60, col.8, lines 24-35).

Regarding claim 10, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a desktop or laptop computer (col.3, lines 18-43, col.7, lines 1-7, 53-60, col.8, lines 24-35).

Regarding claim 11, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a handheld device (col.7, lines 29-33).

Regarding claim 13, Cloutier, as applied to claim 12, teaches that a database for storing identifications of calling parties from whom notifications are transmitted to the preferred device (col.4, lines 5-22).

Regarding claims 23 and 24, Cloutier, as applied to claim 1, teaches that the user's preferred device is a phone/an instant message client, and the incoming call data is converted into a text message notification/an instant message notification of the incoming call (fig.9, step 1014; col.6, lines 62-67, col.9, lines 11-24).

Regarding claim 25, Cloutier, as applied to claim 1, teaches that the incoming call is directed to one of the plurality of devices other than the preferred device (fig.9, step 1000; col.8, lines 17-23, 37-42).

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier in view of Chin (U.S. Patent No. 5,661,788).

Regarding claim 22, Cloutier, as applied to claim 1, does not specifically teach blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call. Chin teaches blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call (fig.2, steps 2k; col.4, lines 63-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cloutier to incorporate the feature of blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call in Cloutier's invention as taught by Chin. The motivation for the modification is to do so in order to filter incoming notification based on choice such that the user can easily informed important notification from a particular person.

*Conclusion*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on MON-FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FAN TSANG can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/  
MD SHAFIUL ALAM ELAHEE  
Primary Examiner  
Art Unit 2614  
June 18, 2010